

### **STATUS OF CLAIMS**

Claims 1-13 are pending in the application. Claim 13 has been amended.

Claims 3-12 were previously withdrawn from consideration as being directed to a non-elected species.

### **INTERVIEW**

Applicant would like to thank Examiner Legesse for her comments and suggestions in the personal interview held January 26, 2009. In the interview, the Examiner and Applicant's representative discussed the section 112, 102, and 103 rejections. Regarding the section 112 rejection, Applicant's representative noted that claim 13 was drawn to the embodiment illustrated in Fig. 1 of the instant specification. The Examiner agreed that the embodiment illustrated in Fig. 1 did not have markings on either the equator or the poles but requested amendment of claim 13 to further clarify the claimed features. The amendments to claim 13 are discussed in more detail below. Regarding the section 102 rejection, Applicant's representative noted that the great circles 7, 8, 9 illustrated in the figures of Sellar are described by Sellar as "imaginary." Thus, the great circles are not **markings** on the ball of Sellar. The Examiner agreed that if the great circles of Sellar are not markings, then Sellar does not anticipate claims 1, 2, and 13. Regarding the 103 rejection, the Examiner indicated she believed there was motivation to combine Koch and Pettigrew. Applicant's representative, however, pointed out that the markings of Koch only provide a qualitative indication of side spin while the claimed polar markings indicate the **amount** of side spin. This distinction is discussed in more detail below. If the Examiner believes further evidence in support of the distinction is warranted, Applicant is prepared to submit such evidence in the form of a declaration under Rule 1.132.

### **Claim Rejections – 35 USC § 112**

The rejection of claim 13 under § 112 is respectfully traversed. Claim 13 has been amended to recite "wherein the two equatorial continuous o-rings surround but do not mark the

equator and the polar markings comprise rings which surround but do not mark the poles.” Claim 1 refers to equatorial o-rings “being spaced close to but equidistant apart from an equator of the ball, and markings printed in the polar regions of the ball...”. In the elected species, the polar markings 14 do not cover the actual poles of the ball; they are within the polar regions but not on the pole itself. Claim 13, which depends from claim 1, specifies that “the two equatorial continuous o-rings surround but do not mark the equator and the polar markings comprise rings which surround but do not mark the poles”, which is clearly the case in Fig. 1. Thus, amended claim 13 is not inconsistent with claim 1. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 13 under 35 USC § 112. .

### **Claim Rejections – 35 USC § 102**

The Examiner has rejected claims 1, 2 and 13 as being anticipated by Sellar. Applicant respectfully contends that the Examiner has misinterpreted Sellar. First of all, Applicant agrees that if the ball disclosed by Sellar inherently provided the benefits of applicant’s invention, the claim would be anticipated; however, applicant submits that it is unquestionably the case that Sellar’s ball cannot provide these benefits.

In the Office Action, the Examiner refers to Sellar’s “two equatorial o-rings (9 as shown in Fig. 3)” as corresponding to applicant’s claimed equatorial rings 10 and 12. This is not the case. As shown below, the o-rings 9 in Sellar are not visible lines imprinted on the golf ball; they are simply imaginary lines used to explain the location of the various “lands” on Sellar’s ball.

First of all, a “land” is a ball spot located amongst the numerous dimples on a golf ball (Sellar, column 1, lines 17-20). Sellar contends that a standard golf ball can be struck during putting in such a way that the dimples will cause the ball to spin resulting in misdirection of the putt (column 2, lines 11-20). The purpose of Sellar’s invention is to ensure “that during the putting stroke, a golfer can align the ball so that a land is in contact with the ground while, simultaneously, a second land can be contacted by the putter head”. (Column 2, lines 31-35). Thus, Sellar’s invention concerns the positioning of lands on a golf ball so that this effect can be achieved, i.e., one

land rests on the green while a second land is struck by the putter. Various different embodiments are disclosed for achieving this objective, but as Sellar makes clear initially the various land designs are portrayed “in terms of **imaginary** great circles alone or as a combination of great circles and complementary great circles...” (Emphasis supplied, column 2, lines 39–47) Thus, as expressly stated by Sellar, the great circles illustrated in the patent are “imaginary”, used simply to show the positioning of the lands. These great circles do not exist on the ball itself and, therefore, obviously would not be visible to the golfer.

Stated in other words, the purpose of the Sellar invention is to make sure that a golf ball can be struck with no side spin. Obviously with this in mind, no thought is given to the marking of a golf ball so that a determination can be made as to whether or not there is sidespin and, if so, the **amount** (the objects of applicant’s invention). In short, Sellar provides a golf ball that tells the golfer what to do before he or she strikes the ball; the invention provides a golf ball which tells the golfer **how well he or she struck the ball**.

Thus, applicant respectfully submits that the Examiner is clearly in error in contending that Sellar discloses equatorial o-rings since the great circles 9 to which the Examiner refers are “imaginary” and, therefore, do not exist on the ball itself. Furthermore, applicant respectfully submits that the Examiner is incorrect in contending that the polar land 16 of Sellar is the same as applicant’s claimed polar marking. Claim 1 specifies that the polar marking must be “sufficiently large so that they become visible to the golfer if side spin is imparted to the ball, with the extent of visibility of the polar markings indicating the amount of side spin imparted to the ball.” A small circular marking as disclosed by Sellar at the pole would not be able to provide an indication of the extent to which side spin has been imparted.

Accordingly, it is respectfully submitted that claims 1, 2 and 13 are not anticipated by Sellar and, therefore, the rejection should be withdrawn.

**Claim Rejections – 35 USC § 103**

Claims 1, 2 and 13 have been rejected under 35 USC § 103(a) as unpatentable over Pettigrew, et al. in view of Koch and as unpatentable over Koch in view of Pettigrew. Both rejections are respectfully traversed.

The Examiner correctly points out that Pettigrew discloses equatorial o-rings 112 comparable to applicant's claimed equatorial o-rings. In both cases, the equatorials indicate whether or not a spin has been imparted to the golf ball. The difference between Pettigrew and applicant's invention is that in applicant's case, special polar markings are provided to indicate the extent of the spin imparted to a ball when it is not properly struck. In applicant's invention, if side spin is caused by the putting stroke, the polar rings become visible during the ensuing roll to a degree proportional to the amount of side spin. The polar o-rings are essentially invisible to the golfer when a ball is properly struck, but if side spin is imparted to the ball, the amount of color appearing on the ball increases in proportion to the amount of side spin. The location of the color due to the polar rings also moves in proportion to the amount of side spin. This is extremely valuable feedback to the golfer who is trying to learn the difference in feel between putting strokes which do not impart side spin (which is desirable) and putting strokes which do. Thus, while the prior art (e.g. Pettigrew, et al.) disclosed the use of o-rings to indicate whether or not spin has been imparted to a putt ball, there is no prior art reference which talks about the need to measure the amount of side spin and there is no prior art reference which discloses an arrangement of golf ball markings in which the measurement of the degree of side spin would be inherent. Clearly, Koch does not make up this deficit.

The purpose of Koch's invention is to provide a golf ball which can be easily identified without touching it (column 1, lines 35-40). For this purpose, Koch applies a multiplicity of marks 25-29 which includes marks at the north and south poles of the ball as shown in the patent, each of the marks is approximately the size of a conventional dimple on the golf ball. Koch points out in column 3, line 52 et. seq. that the equator marks 27 give the appearance of a straight line when the ball is rolling after being struck by a good putting stroke and that the line formed by the rolling

marks will wobble if the ball is struck by a bad putting stroke. Nothing in this patent refers to the use of these marks or any event to provide a **quantitative** measure of the extent of the wobble. This is a critical factor in determining whether or not it is appropriate to combine Pettigrew and Koch, regardless of which is considered to be the primary reference. In Koch, the purpose of the individual marks is to provide a means for identifying a golf ball. Secondly, the equatorial ring formed by the marks indicates whether a putted ball has been struck properly. Pettigrew's ball contains equatorial o-rings which also indicate whether or not the ball has been properly struck. Neither reference discloses any mechanism for indicating the extent of side spin imparted to the ball. Since Pettigrew's ball already includes unique markings (e.g. the bands 112 and target markings 114), there is no need to provide additional markings to identify the ball; the necessary markings are already there. Hence, a person of ordinary skill would not be motivated to add Koch's markings to Pettigrew's ball because it would serve no purpose. Likewise, such a person would not be motivated to add Pettigrew's equatorial markings 112 to Koch's ball because the existing markings already serve the same purpose. Further, even if combined, the combination of Koch and Pettigrew would not result in a ball capable of "indicating the amount of side spin imparted to the ball" as recited in the claims because neither reference discloses any mechanism for indicating the extent of side spin.

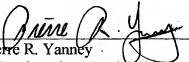
Hence, in the absence of any teaching in the prior art that golf ball markings can be used to measure the extent of side spin imparted to a puttered ball, and considering the fact that no combination of Koch and Pettigrew could provide any useful benefit, the Examiner's proposed combination of these references as a basis to reject applicant's claims 1, 2 and 13 under 35 USC 103(a) is improper.

**REMARKS**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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